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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,615	03/08/2001	Christopher Keith	125468	7375
52531 7590 03/04/2008 CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 03/04/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/803,615

Applicant(s)

KEITH, CHRISTOPHER

Examiner

Narayanswamy Subramanian

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 28-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 28-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicants' communication filed on November 19, 2007. Amendments to claims 1-2, 5-7, 9-10, 28-29, 32-34, 36-39, 42-44 and 46 have been entered. Claims 1-10 and 28-46 are currently pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-10 and 28-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 and 28-46 recite the limitation "automatically controlling execution of the order such that the order is executable by a market participant". It is not clear what the Applicants mean by the term "controlling execution of the order such that the order is executable". The metes and bounds of this limitation are not clear. The response provided by the applicant in their communication does not cure these deficiencies. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Dependent claims contain similar ambiguities like "committing the conditional operation" making the scope of the claims indeterminate. Appropriate correction is required.

The art rejections that follow are interpreted in light of the rejections above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 28-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (US Patent 5,101,353) in view of Korhammer et al. (US Patent 6,278,982 B1).

Claims 1, 28 and 38, Lupien discloses a method, a system and a computer-accessible medium having executable instructions stored thereon for operating an internal market, the method comprising: using a software process executing on a computer, automatically causing a portion or all of an order to be simultaneously available for execution in both the internal market and an external market, wherein the internal and external markets each have a plurality of market participants and are separately capable of executing trades between the market participants, and wherein the same portion or all of the order is simultaneously available for execution by market participants in both the internal and external markets(See Lupien Abstract and Col 3 lines 31-42, broadcasting the order is interpreted to include simultaneously available for execution of the order in various markets); and automatically controlling execution of the order such that the order is executable by a market participant in at most one of the internal market and the external market, without chance of a duplicate execution of the order in more than one of the internal and external markets (See Lupien Abstract and Col 3 lines 43-45, Col 4 lines 32-38, the division of orders ensures that the orders are executable by a market participant in at most one of the internal

market and the external market and there is no duplication of orders). Further the limitation “without chance of a duplicate execution of the order in more than one of the internal and external markets” is interpreted as an intended use of the controlling execution step.

Claims 2-6, 9-10, 29-33, 36-37, 39-43 and 46, Korhammer teaches the steps of automatically synchronizing performance of an operation at the internal market and the external market (See Korhammer Column 12 lines 7-30, coordination of split orders implies synchronization); causing a transaction performed in one of the internal and external markets to be performed in the other of the internal and external markets, the transaction being an operation to cancel or a post an order (See Korhammer Column 12 lines 7-30, causing a transaction to be performed is interpreted as intended use); causing an execute operation performed in one of the internal and external markets to cause a cancel operation to be performed in the other of the internal and external markets (See Korhammer Column 12 lines 7-30, to cause a cancel operation is interpreted as intended use); conditionally performing an operation in one of the internal and external markets, and committing the conditional operation after receiving confirmation from the other of the internal and external markets that the operation has been communicated to the other of the internal and external markets (See Korhammer Column 12 lines 7-30); providing a mechanism for coupling the internal and external markets such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market (See Korhammer Column 11 lines 54-67, for execution by a market participant at either of the internal market or the external market is interpreted as intended use); re-synchronizing an order book containing orders at each of the internal and external markets before decoupling the internal and external markets, wherein the markets, once

decoupled, are capable to separately facilitate an exchange between market participants (See Korhammer Column 12 lines 7-30, wherein the markets, once decoupled, are capable to separately facilitate an exchange between market participants is interpreted as intended use); the automatically ensuring is performed using a software process executing on a computer platform that communicates between the internal market and the external market (Inherent in the disclosure of Korhammer).

Claims 7-8, 34-35 and 44-45, Lupien does not explicitly teach the steps wherein when one of the internal and external markets is in fast symbol mode, the other of the internal and external markets operates as a router and routes orders to the market in fast symbol mode without posting the order at the other of the internal and external markets and wherein an order can be executed at only the market in fast symbol mode.

Official notice is taken executing orders in a market with short latencies, routing the orders to such markets with short latencies and adjusting the orders in the markets before separating the execution in the markets are old and well known in the art. These actions help an investor to realize the best possible prices for his/her transaction in the most time efficient manner.

It would have been obvious to one of ordinary skill in the art to include these features to the invention of Lupien. The combination of disclosures would have helped an investor to realize the best possible prices for his/her transaction in the most time efficient manner.

Response to Arguments

6. In response to Applicant's arguments "Lupien does not teach or suggest the element of "automatically causing a portion or all of an order to be simultaneously available for execution in

both the internal market and an external market..., wherein the same portion or all of the order is simultaneously available for execution by market participants in both the internal and external markets," as claimed in Claim 1. According to Lupien, orders are first broadcast to an internal market (i.e., "other market participants logged into the computer executing this program"). If the orders are not executed within the system, the orders may then be routed to an external market (i.e., "one or more computerized exchanges, brokerage services, market access networks or displayed through its own network"). The routing of orders in the internal and external markets is sequential", the Examiner respectfully disagrees. As discussed in the art rejection, Lupien discloses in the Abstract and Column 3 lines 31-42 broadcasting the order to various markets. The broadcasting the order to various markets is interpreted to include simultaneously available for execution of the order in various markets. Further the division of orders ensures that the orders are executable by a market participant in at most one of the internal market and the external market and there is no duplication of orders. For instance if 50% of the order is sent to one market and the remaining sent to another market the same portion of the order is simultaneously available for execution in both the markets. Hence Lupien teaches the feature automatically controlling execution of the order such that the order is executable by a market participant in at most one of the internal market and the external market, without chance of a duplicate execution of the order in more than one of the internal and external markets.

In response to Applicant's arguments "Since a prima facie case of obviousness under Section 103 requires that all elements of a claim be taught in the prior art, which is not shown with Lupien, the rejection of Claim 1 should be withdrawn", the Examiner would like to point out that in view of *KSR V. Teleflex 82 USPQ2d 1385*, the prior art references need not teach or

suggest all of the claim limitations. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. Prior art is not limited just to references being applied, but includes the understanding of one of ordinary skill in the art.

Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3691

March 3, 2008